IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jenuwein et al.

Appl. No.: 10/773,302

Filed: February 9, 2004

For: Chromatin Regulator Genes

Confirmation No.: 8734

Art Unit:

1651

Examiner:

To Be Assigned

Atty. Docket: 0652.1670002/JUK/JCI

Information Disclosure Statement Under 37 C.F.R. § 1.97(b)

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Sir:

NOV 2 3 2004

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are not submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003. Copies of documents AL1 to AL2 and AR1 to AR66 are provided.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following discussion of the relevance of the non-English language document AM1 cited on Form PTO 1449:

Document AM1, DE 195 16 776, is in the German language. An English language abstract of document AM1 is attached as document AT65.

The Examiner's attention is directed to the following co-pending applications which are directed to related technical subject matter:

- U.S. Application No. 09/500,991, Uhlmann *et al.*, filed February 15, 2000, now pending, and submitted herewith as document AR65;
- U.S. Application No. 09/876,224, Jenuwein et al., filed June 8, 2001, now published as U.S. Patent Application Publication No. 2002/0039776 A1, and listed as document AD1;
- U.S. Application No. 10/051,311, Peters *et al.*, filed January 22, 2002, now published as U.S. Patent Application Publication No. 2002/0164620 A1, and listed as document AE1;
- U.S. Application No. 10/302,904, Jenuwein *et al.*, filed November 25, 2002, now published as U.S. Patent Application Publication No. 2003/0104599 A1, and listed as document AG1;
- U.S. Application No. 10/323,968, Jenuwein *et al.*, filed December 20, 2002, now published as U.S. Patent Application Publication No. 2003/0157532 A1, and listed as document AH1.

The identification of these U.S. Patent Applications is not to be construed as a waiver if secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Applicants would like to bring to the Examiner's attention document AT59, Wreggett, K.A. et al., for which Applicants were unable to determine the month of

publication. Applicants would also like to bring to the Examiner's attention document AT27, Jolley, M.E., for which Applicants were unable to determine the exact month of publication.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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Judith U. Kim Attorney for Applicants Registration No. 40,679

Date: November 23, 2004

1100 New York Avenue, N.W. Washington, D.C. 20005-3934 (202) 371-2600

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	ATTY. DOCKET NO. 0652.1670002/JUK/JCI	APPLICATION NO. 10/773,302
FORM PTO-1449	FIRST NAMED INVENTOR	
	Jenuwein et al.	
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	AR	11	HP1 in the g	t al., "SU(VAR) genomic silencir ress (Septembe	3-7, a <i>Drosophila</i> heterocing of position-effect varieger 1997)	hromatin-a jation," <i>The</i>	issociat e <i>EMBC</i>	ed protein and o Dournal 16:528	companion of 80-5288, Oxford
	AS	11	topoisomera	al., "Meiotic eve ase IIα localizati ember 1999)	ents at the centromeric he ion and chromosome cond	terochrom densation,"	atin: his	tone H3 phosph osoma 108:412	norylation, -425, Springer-
	AT	11	dependent o	degradation of t	hase initiation in Sacchard the anaphase inhibitor Pds December 1996)	omyces ce s1p," Gene	revisiae s & Dev	is controlled by . 10:3081-3093	the APC- c, Cold Spring
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	AR	<u>12</u>	Cortez, D Publishin	o. and Elledge, S g Group (July 20	S.J., "Conducting the mitot 000)	tic symphony," <i>Natu</i>	ıre 406:354-356,	Nature
	AS	12	Csink, A. organizat	and Henikoff, S ion in <i>Drosophil</i> a	., "Genetic modification of a," <i>Nature 381</i> :529-531, N	f heterochromatic a Nature Publishing G	ssociation and no roup (June 1996	uclear)
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	AT	13	Dernburg, Interaction	A.F., <i>et al.</i> , "Pers," <i>Cell 85</i> :745-	rturbation of Nuclear Arch 759, Cell Press (May 1996	itecture by 6)	/ Long-Di	stance Chromos	some
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	AS	14	De Rubertis, F. et al., "The histone deacetylase RPD3 counteracts genomic silencing in Lyeast," Nature 384:589-591, Nature Publishing Group (December 1996)					
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	AR	<u>16</u>	Drosophil	rg, J.C., et al., la With Dosage Society of Ame	"The Heterochromatin-Ass -Dependent Effects on Po erica (1992)	ociated Protein HP sition-Effect Variega	1 Is an Essentia ation," <i>Genetics</i>	Il Protein in 131:345-352,
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	AR	18	Foon, K.A. Hematolog (January 1	y, Handin, R.I.	P. "Chronic Lymphoid Leul , <i>et al.</i> , eds., J.B. Lippinco	kemias," in: <i>Blood: I</i> tt Company, Philado	Principles and Preliphia, PA, pp. 7	ractice of 83–811		
	AS	18	Friedman, L.S., et al., "The Search for BRCA1," Cancer Res. 54:6374-6382, American Association for Cancer Research (December 1994)							
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	AR	<u>19</u>	Funabiki, 381:438-4	H., <i>et al.</i> , "Cut I41, Nature Pu	2 proteolysis required for s ublishing Company (May 19	ister-chromatid sepa 196)	aration in fission	yeast," <i>Nature</i>
	AS	19	Garzino, variegatio	V., et al., "Cell n in <i>Drosophil</i>	lineage-specific expression a," EMBO J. 11:4471-4479	n of <i>modulo</i> , a dose , Oxford University	-dependent mod Press (1992)	lifier of
	АТ	19	encoded	protein: Trans-	say for trans-activation usir -activation requires mRNA ciences (1989)	ng purified human ir synthesis," <i>Proc. N</i> a	nmunodeficienc atl. Acad. Sci. U	y virus <i>tat-</i> SA 86:821-824,
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	AR	20	Geraghty, 16:440-446	M.T., <i>et al.</i> , "Th ծ, Academic Pr	ne Isolation of cDNAs from ess, Inc. (1993)	OATL1 at Xp11.2 U	Jsing a 480-kb \	(AC," Genomics
	AS	20	Intramolect	ch, A.A. and Kh ular fluorescend cience B.V. (De	nolodovych, V.V., "Fluoroge ce energy transfer (IFETS) cember 1996)	enic substrates for p)," <i>J. Biochem. Biop</i>	oroteases based hys. Methods 33	on 3:135-162,
	АТ	20	Gibbons, R Retardation	LJ., <i>et al.</i> , "Muta n with α-Thalas	rations in a Putative Global ssemia (ATR-X Syndrome)	l Transcriptional Reç ," <i>Cell 80</i> :837-845, (julator Cause X Cell Press (Marc	-Linked Mental ch 1995)
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	АТ	22	Grunstein 93:325-32	, M., "Yeast H 28, Cell Press	eterochromatin: Regulatio (May 1998)	on of Its Assembly ar	d Inheritance by	Histones," Cell
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	AS	29	Karpen, C	Karpen, G.H. and Allshire, R.C., "The case for epigenetic effects on centromere identity and function," Trends Genet. 13:489-496, Elsevier Science Ltd. (December 1997)						
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	AS	36	Losada, A	., et al., "Identi Genes & Dev	fication of <i>Xenopus</i> SMC 12:1986-1997, Cold Spi	protein complexes r ring Harbor Laborato	equired for siste ry Press (July 19	r chromatid 998)
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	AS	38	Meistrich, M.L. and Brock, W.A., "Proteins of the Meiotic Cell Nucleus," In <i>Meiosis</i> , Moens, P.B., ed., Academic Press, New York, N.Y., pp.333-353 (1987)							
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	AR	<u>63</u>	GenBank F	Report for Acc	ession No. AAD39289, fr	om Federspiel, N.A. o	e <i>t al.</i> (last updat	ed October 2002)
	AS	63	GenBank F	Report for Acc	ession No. D31891, from	Nomura, N., et al. (k	ast updated Jan	uary 2004)
	АТ	63	GenBank F	Report for Acc	ession No. D79987, from	Nagase T., et al. (la	st updated Janu	ary 2004)
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		Page 64 of	66
	ATTY. DOCKET NO. 0652.1670002/JUK/JCI	APPLICATION NO. 10/773,302	
FORM PTO-1449	FIRST NAMED INVENTOR		
	Jenuwein et al.	ART UNIT	_
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	AR	GenBa	ink Report for A	Accession No. L08238, fron	n Geraghty, M.T. (last	updated Januar	y 1995)		
	AS .	GenBa	GenBank Report for Accession No. U18003, from Ostermeyer, E.A. (last updated August 1998)						
	АТ	GenBa	GenBank Report for Accession No. U52965, from Hobert, O., et al. (last updated July 1996)						
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	ATTY, DOCKET NO. 0652,1670002/JUK/JCI	APPLICATION NO. 10/773,302
FORM PTO-1449	FIRST NAMED INVENTOR	
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	AS	<u>65</u>	Internationa 2000	al Search Repo	ort for International P	atent Applicatio	on No. PCT	T/EP00/01183,	mailed June 29,
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